



03-24-08

1 Rm AP

Walker & Jocke

a legal professional association

Ralph E. Jocke

Patent

&

Trademark Law

March 19, 2008

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: **Application Serial No.:** 09/505,594
Appellants: Jay Paul Drummond, et al.
Filing Date: February 16, 2000
Confirmation No.: 5969
Title: Method And System For Connecting Services To Automated Transaction Machine
Docket No.: D-1120 R1

Sir:

Please find enclosed the Appellant's Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-referenced application.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 this 21st day of March, 2008.

EM 153891620 US
Express Mail Label No.

Ralph E. Jocke

330 • 721 • 0000
MEDINA

330 • 225 • 1669
CLEVELAND

330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1120 R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit 3624
Serial No.: 09/505,594)	
)	
Confirm. No.: 5969)	
)	
Filed: February 16, 2000)	Patent Examiner
)	Narayanswamy
For: Method And System For)	Subramanian
Connecting Services To An)	
Automated Transaction Machine)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The present Reply Brief is in response to the Examiner's present Answer ("present Answer") dated January 24, 2008.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

STATUS OF CLAIMS

Claims 1-54 are pending in the Application.

Claims rejected: 1-11, 45 and 46

Claims allowed: none

Claims confirmed: none

Claims withdrawn: 12-44 and 47-54

Claims objected to: none

Claims canceled: none

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. § 103(a) over Coutts, et al., U.S. Patent No. 6,311,165 ("Coutts").

ARGUMENT

The present Answer dated January 24, 2008 appears to substantially correspond to the Answer dated December 22, 2005 with the addition of a few clarifications added in response to the Order Remanding to the Examiner dated November 2, 2007. With respect to the duplicate subject matter included in the present Answer, Appellants' respectfully request the Board to review Appellants' arguments presented in Appellants' Appeal Brief dated December 23, 2004 and Reply Brief dated February 14, 2006, which are hereby restated, and which prior submissions are incorporated by reference herein in their entirety.

The present Reply is directed to the clarifications included in the present Answer. These clarifications include a statement that the Sun Microsystems reference "is only provided in support of the official notice taken and hence does not constitute a new grounds of rejection" (See page 10, lines 3-4). The statements in the present Answer also include the Examiner's assertion on page 11, lines 13-19 that:

The revision date of January 25, 1999 [for the Sun Microsystems reference] was the date when the document was made public. For instance the reference "it's out of the bottle - Sun introduces JINI[™]" dated January 25, 1999 discusses "Developers have been given early access to Jini connection technology for over six months. Jini technology is available today as shipping product On Sun's web site at: <http://www.sun.com/jini>". Hence it is clear that this technology was available to the public at least on January 25, 1999. Hence the Sun Microsystems reference qualifies as prior art.

Appellants respectfully submit that these assertions do not overcome the improper citation to “Official Notice” in the rejections. Nor do these assertions provide any evidence that the Sun Microsystems reference was publicly available prior to Appellants' effective filing date. As a result, there is no legal basis to take “Official Notice” that the Sun Microsystems reference is prior art.

For example, in the present Answer the Examiner has confirmed that claims 1-11, 45 and 46 stand rejected only in view of Coutts, et al. US Patent 6,311,165, (“Coutts”). The Office has not rejected any of the claims in view of the Sun Microsystems reference. Further it appears the Office has purposefully decided that the Sun Microsystems reference cannot be directly applied in a rejection against the pending claims (even when prompted by the Board). Thus, if the Sun Microsystems reference cannot be applied in the rejection directly (because it has not been shown to constitute prior art), Appellants respectfully submit that this reference also cannot be used to support an assertion of “Official Notice” regarding features and relationships admitted by the Office as not being taught by Coutts.

Further, even if the Office were to attempt to apply a new ground of rejection in view of the Sun Microsystems reference, Appellants respectfully submit that the present Answer still has not been able to establish that the Sun Microsystems reference is prior art. When there is actual extrinsic evidence to the contrary, a “revision date” (such as January 25, 1999) printed on a cover page of a reference, does not establish that the reference was publicly available as of the “revision date”. As discussed in Appellants' Answer dated February 14, 2006, the extrinsic evidence shows that the earliest date on

which it can be shown that the Sun Microsystems reference was publicly available is April 21, 2000. That date is after Appellants' priority and filing dates, and the Office has been unable to refute Appellants' extrinsic evidence and/or provide any evidence that the Sun Microsystem reference was publicly available earlier than Appellants' priority date.

Further, the allegation in the present Answer that the reference states that "Jini technology is available today as a shipping product" provides no evidence that the Sun Microsystems reference constitutes prior art to the present application. Later posted statements on a Sun Microsystems web site that "Developers have been given early access to Jini connection technology for over six months" does not provide any evidence that this specific Sun Microsystems reference was ever given to such developers. Even if the later statement was accurate, such access could have been given under a non-disclosure agreement or similar agreement which required the developers to keep the information regarding Jini technology, or any use of Jini, secret and non-public. Such secret, non-public use does not constitute prior art.

With respect to Coutts, the present Answer acknowledges that Coutts does not teach the recited feature in all of the pending claims of:

- **the second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store;**

Because the Office has been unable to supply any prior art evidence which shows that these recited features and relationship were known in the prior art, the Office has not established *prima facie* obviousness with respect to the pending claims. On this basis, all of the rejections should be reversed.

In addition, even if all of the features recited in a claim were known in the prior art (which has not been established), it is still not proper to reject a claim on the basis of obviousness unless there is an identified valid reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007). Thus, even if it were possible for the Sun Microsystems reference to qualify as prior art (which it does not) or for the Official Notice assertions to be accurate (which they are not), the present Answer does not identify any apparent reason in the prior art for combining Coutts and the Sun Microsystems reference. Further, the present Answer is totally devoid of any reason or motivation to combine the Sun Microsystems reference with Coutts.

The Sun Microsystems reference does not disclose or suggest an automated transaction machine, which in the exemplary embodiment described in Appellants' Specification comprises an Automated Teller Machine (ATM). Further, the Sun Microsystems reference does not disclose or suggest using the described Jini™ architecture in an automated transaction machine or an ATM. Similarly, Coutts does not disclose or suggest using anything comparable to the Jini™ architecture described in the Sun Microsystems reference. Also, Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the

Sun Microsystems reference provide any apparent reason to combine the features in the references in a manner which includes each and every feature and relationship recited in the pending claims.

Further, as discussed in the Appeal Brief, Coutts teaches a system which provides a direction of communication and a manner of operation directly opposite to that of the recited invention. In Coutts, devices only download software to the device from a server. Coutts does not disclose or suggest devices that are capable of uploading their drivers from the devices to a data store.

In addition, Coutts specifically teaches away from Appellants' recited features. For example at Column 21, lines 22-27, Coutts states that: "Although the peripherals 364 are connected to the server 334 via the router 368, each peripheral 364 has independent access to the server 334 and is operable to download software modules directly therefrom (i.e. software modules are not first downloaded to an intermediate location and then copied to the peripherals 64 from the intermediate location)". By stating that software modules are not downloaded to an intermediate location, Coutts expressly discourages one of ordinary skill in the art from considering modifications (such as the subject matter of claim 1) which is contrary to such a teaching.

Also for example, Coutts specially teaches at Column 25, lines 5-12 that: "By having a direct connection from the peripherals 364 to the server 334 it is possible to allow the peripheral software applications to take a more active role in the overall operational flow of the ATM 362. This allows the user interface processor to concentrate on its primary tasks of providing user interface display graphics, animation and video

facilities. The processing power required to operate individual peripherals 364 can then be selected to optimize the cost/performance ratio". This teaching of Coutts clearly argues the advantages and utility of downloading software modules from a remote server **directly** to peripheral devices. Modifying Coutts to communicate device drivers in the opposite direction to that expressly taught by Coutts (as claimed by Appellants) would destroy the specific advantages and utility taught by Coutts.

An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the cited Coutts reference, it is respectfully submitted that the rejections are improper and should be reversed.

In addition the Office's attempts to argue "Official Notice" to combine the alleged teachings with Coutts are clearly nothing more than attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 1-11, 45 and 46 over Coutts are not legally supported, are improper and should be reversed.

CONCLUSION

The evidence of record and the statutory tests all establish that Appellants' claimed invention is patentable. Reversal of all of the rejections is respectfully requested.

Respectfully submitted,



Ralph E. Locke Reg. No. 31,029
231 South Broadway
Medina, Ohio 44256
(330) 721-0000